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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mulham Bayassi

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7267

22511

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07/06/2004

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EXAMINER

ENG, GEORGE

ART UNIT

PAPER NUMBER

2643

9

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/019,787

**Applicant(s)**

BAYASSI, MULHAM

**Examiner**

George Eng

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10,12-20,22-30 and 32-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10,12-20,22-30 and 32-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                                        |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is in response to the amendment filed 4/1/2004 (paper no. 7).

### ***Information Disclosure Statement***

2. The information disclosure statement filed 6/1/2004 (paper no. 8) has been considered.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 12-13, 16-20, 22-30 and 34-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oi (JP 10-210072 A) in view of Bosco (US PAT. 6,335,963).

Regarding claim 1, Oi discloses a method of notifying a user of the receipt of an e-mail by a mail center (2, figure 1) comprising transmitting a notification message in a broadcast signal, wherein the notification message comprising mail reception data (abstract). Oi differs from the claimed invention in not specifically teaching the mail reception data comprising at least part of the text of the e-mail, and receiving a request for the notification message to be transmitted. However, Bosco teaches an electronic mail system providing a user with notification

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of a received e-mail message by receiving a request for notification message to be transmitted (steps 440-460, figure 4 and col. 5 lines 7-160, wherein the notification comprising what to send information including at least part of the text of the e-mail (col. 5 line 63 through col. 6 line 1 and col. 6 lines 44-47) in order make user friendly by providing different options regarding information in the notification or alert consistent with the capabilities of user's communication equipment. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oi in having the mail reception data comprising at least part of the text of the e-mail, and receiving a request for the notification message to be transmitted, as per teaching of Bosco, in order make user friendly by providing different options regarding information in the notification or alert consistent with the capabilities of user's communication equipment.

Regarding claim 2, Oi discloses the notification message being sent without user prompt (abstract), as well as Bosco (col. 1 lines 38-48).

Regarding claims 3-5, Oi teaches the notification message including an identifier of a receiver (6, figure 1) to which the notification to be sent and the receiver compares the identifier with stored identifier, i.e., a smart card number, at the receiver (detailed description, paragraphs [0024] and [0035]).

Regarding claims 6-8, Bosco teaches a database at a central location for storing information related to e-mail accounts linked with unique ID and what to send information, i.e., identifiers of receivers or smart card numbers of the receivers, wherein the broadcast signal is part of a subscription service and information relating to e-mail accounts is linked to information

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relating to the subscription service in order to enhance the system to notify or alert a user consistent with the user's subscription (col. 2 line 58 through col. 5 line 25).

Regarding claims 9-10, Bosco discloses the notification message comprising an identifier of the recipient of the e-mail and an identifier of the sender of the e-mail (col. 6 lines 45-52).

Regarding claims 12-13, Oi clearly discloses the notification message being sent to a receiver (6, figure 1), wherein the receiver generates a signal for indicating to the user receipt of the e-mail by the mail center (detailed description, paragraph [0039]).

Regarding claims 16-18, Oi discloses that the broadcast signal is a digital data stream, wherein the notification is sent as a section of the digital data stream by way of an entitlement management message (detailed description, paragraphs [0041] through [0043] and paragraph [0046]).

Regarding claim 19, Oi disclose a method of notifying a user (i.e. user A) of the receipt of e-mail by a mail center (2, figure 1), which e-mail is to be transmitted to the user via a first medium (i.e., a terminal unit 4, figure 1), comprising transmitting a notification message, indicating the receipt of e-mail by the mail center to the user via a second medium (i.e., a television 7, figure 1), different from the first medium (abstract and detailed description, paragraphs [0020] through [0024]). Oi differs from the claimed invention in not specifically teaching the notification message comprising at least part of the text of the e-mail, and receiving a request for the notification message to be transmitted. However, Bosco teaches an electronic mail system providing a user with notification of a received e-mail message by receiving a request for notification message to be transmitted (steps 440-460, figure 4 and col. 5 lines 7-160, wherein the notification comprising what to send information including at least part of the text of

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the e-mail (col. 5 line 63 through col. 6 line 1 and col. 6 lines 44-47) in order make user friendly by providing different options regarding information in the notification or alert consistent with the capabilities of user's communication equipment. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oi in having the notification message comprising at least part of the text of the e-mail, and receiving a request for the notification message to be transmitted, as per teaching of Bosco, in order make user friendly by providing different options regarding information in the notification or alert consistent with the capabilities of user's communication equipment.

Regarding claim 20, Oi discloses that the first medium is a switched medium and the second medium is a broadcast medium (figure 1 and detailed description, paragraphs [0023] and [0024]).

Regarding claim 22, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 23, Oi discloses a method of communicating with a mail center (2, figure 1) comprising running an e-mail application on a receiver (abstract and detailed description, paragraph [0035]).

Regarding claim 24, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 25, the limitations of the claim are rejected as the same reasons set forth in claims 3-5.

Regarding claims 26-28, the limitations of the claims are rejected as the same reasons set forth in claims 6-8.

Regarding claims 29-30, the limitations of the claims are rejected as the same reasons set forth in claims 9-10.

Regarding claims 34-36, the limitations of the claims are rejected as the same reasons set forth in claims 16-18.

Regarding claim 37, Bosco teaches the notification comprising what to send information including at least part of the text of the e-mail (col. 5 line 63 through col. 6 line 1 and col. 6 lines 44-47).

Regarding claim 38, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 39, the limitations of the claim are rejected as the same reasons set forth in claim 19.

Regarding claim 40, the limitations of the claim are rejected as the same reasons set forth in claim 20.

Regarding claim 41, Oi discloses a receiver (6, figure 1) for receiving and decoding a broadcast signal comprising means for receiving a notification message for notifying a user of the receipt of e-mail by a mail center (4, figure 1) together with a broadcast signal (abstract and detailed description, paragraphs [0035] through [0041]). Oi differs from the claimed invention in not specifically teaching the mail reception data comprising at least part of the text of the e-mail in the broadcast signal. However, Bosco teaches an electronic mail system providing a user with notification comprising what to send information including at least part of the text of the e-mail (col. 5 line 63 through col. 6 line 1 and col. 6 lines 44-47) in order make user friendly by providing different options regarding information in the notification. Therefore, it would have

been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oi in having the mail reception data comprising at least part of the text of the e-mail, as per teaching of Bosco, in order make user friendly by providing different options regarding information in the notification.

Regarding claims 42-43, the limitations of the claims are rejected as the same reasons set forth in claims 3-5.

Regarding claim 44, Oi teaches the receiver generates a signal indicating the receipt of e-mail by the mail center (abstract and detailed description, paragraph [0035]).

Regarding claim 45, Oi discloses the receiver generating a signal for displaying at least part of the notification message (detailed description, paragraph [0062]).

Regarding claim 46, Oi discloses a receiver for receiving and decoding a broadcast signal comprising means for receiving e-mail via a first medium and means for receiving a notification message indicating the receipt of e-mail by the mail center, via a second medium different from the first medium (abstract and detailed description, paragraphs [0020] through [0024]). Oi differs from the claimed invention in not specifically teaching the notification message comprising at least part of the text of the e-mail. However, Bosco teaches an electronic mail system providing a user with notification comprising what to send information including at least part of the text of the e-mail (col. 5 line 63 through col. 6 line 1 and col. 6 lines 44-47) in order make user friendly by providing different options regarding information in the notification. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oi in having the notification message comprising at least part of the text of the e-mail, as per



teaching of Bosco, in order make user friendly by providing different options regarding information in the notification.

Regarding claim 47, the limitations of the claim are rejected as the same reasons set forth in claim 20.

Regarding claim 48, Oi discloses a system for notifying a user of the receipt of e-mail comprising an apparatus (3, figure 1) for notifying a user of the receipt of e-mail by a mail center (2, figure 1) and a receiver (6, figure 1) for receiving and decoding a broadcast signal, the apparatus comprising means (26, figure 1) for transmitting a notification message in the broadcast signal, and the receiver comprising means for receiving a notification message for notifying the user of the receipt of e-mail by the mail center together with the broadcast signal (abstract and the entire detailed description). Oi differs from the claimed invention in not specifically teaching the apparatus comprising means for receiving a request for the notification message to be transmitted and the receiver comprising means for receiving at least part of the text of the e-mail. However, Bosco teaches an electronic mail system providing a user with notification of a received e-mail message by receiving a request for notification message to be transmitted (steps 440-460, figure 4 and col. 5 lines 7-160, wherein the notification comprising what to send information including at least part of the text of the e-mail (col. 5 line 63 through col. 6 line 1 and col. 6 lines 44-47) in order make user friendly by providing different options regarding information in the notification or alert consistent with the capabilities of user's communication equipment. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Oi in having the apparatus comprising means for receiving a request for the notification message to be transmitted and the receiver

comprising means for receiving at least part of the text of the e-mail, as per teaching of Bosco, in order make user friendly by providing different options regarding information in the notification or alert consistent with the capabilities of user's communication equipment.

5. Claims 14-15 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oi (JP 10-210072 A) in view of Bosco (US PAT. 6,335,963) as applied to claims above, and further in view of Duphorne (US PAT. 6,212,265).

Regarding claims 14-15, the combination of Oi and Bosco differs from the claimed invention in not specifically teaching to store preferences selected by the user and to notify the user of the selected number of e-mails. However, Duphorne discloses a method for electronic mail notification comprising a parameter database (14c) for storing preferences selected by the user and filtering information to notify the user of a selected number of e-mails in order to make user friendly (col. 4 line 32 through col. 5 line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Oi and Bosco in storing preferences selected by the user and notifying the user of the selected number of e-mails, as per teaching of Duphorne, in order to make user friendly.

Regarding claims 32-33, the limitations of the claims are rejected as the same reasons set forth in claims 14-15.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-10, 12-20, 22-30 and 32-48 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Uchida et al. (US PAT. 6,327,610) discloses a broadcast communication system for broadcasting electronic mails that separately stores and sends a portion of electronic mails with an access code for filtering and retrieving purpose (abstract). Eguchi (US 2001/0040694) discloses a communication terminal device with electronic mail communication capabilities creating image data indicating transmission of electronic mail to a recipient (abstract).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9306 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



George Eng  
Primary Examiner  
Art Unit 2643